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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 10992120-4	
I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office - facsimile number (571) 273-8300. on <u>November 15, 2005</u> Signature <u>Doreen Melchior</u>		Application Number 10/705,301	Filed 11/10/03
Typed or printed name <u>Doreen Melchior</u>		First Named Inventor Beck et al.	Examiner L. Nguyen
Art Unit 2853			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		 Signature <u>Petar Kraguljac</u> Typed or printed name	
<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/86)			
<input checked="" type="checkbox"/> attorney or agent of record Registration number <u>38,520</u>		<u>(216) 348-5843</u> Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>November 15, 2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	)	Examiner: L. Nguyen
Beck et al.	)	
	)	Art Unit: 2853
Serial No.: 10/705,301	)	
	)	
Filed: November 10, 2003	)	
	)	
For: Integrated Control Of Power Delivery	)	
For Firing Resistors For Printhead	)	
Assembly (As Amended)	)	
	)	
Date of Final Office Action:	)	Attorney Docket No.:
August 15, 2005	)	10992120-4
	)	
Date of Advisory Action	)	
November 2, 2005	)	
	)	
November 15, 2005		

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

and

## ACCOMPANYING ARGUMENTS

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Dear Sir:

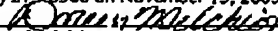
Applicant respectfully requests a Pre-Appeal Brief Review for the final rejection of the present application. The present request includes accompanying arguments and is being filed with a Notice of Appeal.

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**CERTIFICATE OF FACSIMILE**

Date of Deposit: November 15, 2005

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Doreen Melchior

Docket No. 10992120-4

**Summary of The Final Office Action**

**Claims 1, 3, 6-8, 13, 23, 26, 28-29** stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohorquez (U.S. 5,357,081) in view of Suzuki (U.S. 4,514,737).

**Claims 2, 4, 5, 11-12, 24-25, 27** stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohorquez (U.S. 5,357,081) in view of Suzuki (U.S. 4,514,737), as applied to claims 1, 23, and further in view of Doluca (US 6,208,127).

**Claim 14** stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohorquez (U.S. 5,357,081) in view of Suzuki (U.S. 4,514,737), as applied to claim 13, and further in view and further in view of Otsuki (US 6,145,961).

**Allowable Subject Matter**

**Claim 9-10** stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Accompanying Arguments for Review**

Applicant respectfully requests a Pre-Appeal Brief Review for the Final Rejection that was issued August 15, 2005. The present Accompanying Arguments are less than five pages.

**Advisory Action – Improper Definition of Claim Terms**

The Advisory Action (issued November 2, 2005) states that Applicant's request for reconsideration (filed October 17, 2005) does not place the application in condition for allowance. The rejections are based on a definition of claim terms created by the Examiner, which is a clear error in the rejections. Applicant appeals all of the present rejections.

In particular, the primary reason applied was founded on a dictionary definition of the term "offset". The Advisory Action states that, "as based on the definition that "offset" is "something that serves to counterbalance or to compensate for something else"" and cites Merriam-Webster's Collegiate Dictionary, Tenth Edition, page 805. Using this dictionary definition, the Examiner then elaborated the dictionary definition even further to create a definition of "offset voltage" as:

"any electrical signal, either discrete or continuous, digital or analog, unipolar or bipolar, that has a voltage value and being used as an input to adjust "something" in order to compensate for "something else" is considered as "an offset voltage." (Adv. Action)

This elaborated definition goes beyond the dictionary definition and no source or reference was cited as to its origin. The elaborated definition was then the basis for concluding that the cited references of Bohorquez and Suzuki teach the present claims based on an inherency argument (see Advisory Action, page 2, line 7: "...Fig. 3, inherently has a voltage value..."). Even though the inherency argument does not explain how the references actually teach the claimed power regulator and how it provides the offset voltage or how the claimed multiple primitives and group of switches are controlled by the offset voltage (see present claims 1, 13, 28), Applicant focuses on the improper definition. The arguments relating to omissions in the rejections are provided in a subsequent section below.

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Applicant respectfully submits that the dictionary definition and the elaborated definition were not taken in light of the present specification nor made in the context of the present claims or specification. The Federal Circuit in Phillips v. AWH Corporation, 415 F.3d 1303, 75 U.S.P.Q.2D (Fed. Cir. 2005) has clearly stated that reliance on a dictionary in this manner is improper. In Phillips, the Federal Circuit stated:

Properly viewed, the "ordinary meaning" of a claim term is its meaning to the ordinary artisan after reading the entire patent. Yet heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification. The patent system is based on the proposition that claims cover only the invented subject matter. *Id.* at 1321.

Applicant respectfully submits that the definition of the term "offset voltage" created by the Examiner is divorced from the intrinsic evidence and is thus improper under Phillips. The claims have not been construed so as to be consistent with the specification. Rather, it seems that the scope and definition of the claim terms have been manipulated in order to improperly cure omissions in the cited teachings and to justify finding inherent teachings where no actual teachings exist. Thus, the rejections are based on a flawed analysis that is not supported by either 35 U.S.C. §102, §103, or the Federal Circuit.

If the Examiner read the claims in light of present specification, the meaning of offset voltage in the context of the present claims would be understood. For example, from page 13, lines 8-32, or page 15, line 13 to page 16, line 11, or page 17, the present specification provides descriptions that allow one of ordinary skill in the art to understand the present claims. And, based on the actual context and scope of the claims, one of ordinary skill would not believe that the present claims are taught or suggested by Bohorquez and Suzuki. The particular reasons for this conclusion is provided in the following section. Thus, the present rejections are based on an improper definition and, the present rejections are not supported by the teachings of Bohorquez and Suzuki. Therefore, the rejections must be withdrawn.

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**The Claim Patentably Distinguishes Over The References Of Record**

As encourage by the Patent Office, Applicant refers to the arguments already of record rather than repeating them in the present request. In particular, Applicant refers to pages 7-12 in the "Response to Final Rejection" previously submitted October 17, 2005 to support Applicant's position the cited references do not teach or suggest each and every claimed element of the present application. The Paper Number is unknown since the Paper Number Field in previous Patent Office Correspondence has not been filled in.

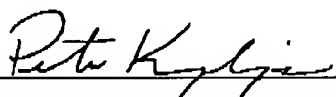
For the reasons set forth herein and in previous submissions, the Examiner's rejections are based on improper definitions and contain omissions of one or more essential elements needed for a prima facie rejection. Therefore, the cited references fail to support the rejections and the rejections must be withdrawn.

**Conclusion**

For the reasons set forth above, claims 1-14 and 23-29 patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

Nov. 15, 2005

  
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